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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,129	01/20/2004	Hiromu Ando	Q79438	6649

23373 7590 03/07/2006
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EXAMINER

LAMB, BRENDA A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,129

Applicant(s)

ANDO ET AL.

Examiner

Brenda A. Lamb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is confusing since it is unclear how "a primary coating liquid supply flow path" relates to "a coating liquid supply flow path" set forth at line 10 of claim 1. The recitation in claim 4 that the apparatus is further comprised of an air-liquid interface forming portion is confusing since it appears from the specification and drawings that the air-liquid interface forming portion is defined by a cooperative relationship between elements of the apparatus which includes the between-bars liquid reservoir.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the air-liquid interface forming portion must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Peiffer 5,843,529.

Peiffer teaches the design of a coating apparatus for coating with coating liquid a surface of a strip-shaped body carried in a fixed direction, the apparatus comprising: a primary bar 16 extending along a width direction of a carrying plane, which is a carrying path of the strip-shaped body; a secondary bar 24 extending in parallel with the primary bar and disposed at a downstream side of the primary bar; and a between-bars liquid reservoir 18, the reservoir as shown in Figure 1 extends between the primary bar and the secondary bar for storing the coating liquid at a time of coating of the coating liquid. Peiffer shows in Figure 1 that the coating conditions at the primary bar which is supplied with the coating liquid by a coating liquid supply flow path of coating in the reservoir, and the secondary bar are set so that $W2 < W1$ where $W1$ is a coating amount of the coating liquid that is deposited on the strip-shaped body at the primary bar and $W2$ is a coating amount of the coating liquid that is deposited on the strip-shaped body after the strip-shaped body has passed the secondary bar since the secondary bar 24 removes coating from the web and applied by the primary bar therefore the total amount of coating left on the strip as the strip passes the secondary bar or $W2$ is less than $W1$. Thus every element of the claimed apparatus is taught by Peiffer. With respect to claim 7, Peiffer is capable of coating strip-shaped body within the scope of the claim since it teaches every element of the apparatus. Note it has been held that a recitation with

respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 4, Peiffer shows the coating apparatus includes an air-liquid interface forming portion for forming an air-liquid interface, which is an interface between the coating liquid and air, at the between-bars liquid reservoir at a time of coating.

Claims 1,4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Mahoney 3,424,126.

Mahoney teaches the design of a coating apparatus for coating with coating liquid a surface of a strip-shaped body carried in a fixed direction, the apparatus comprising: a primary bar 16 extending along a width direction of a carrying plane, which is a carrying path of the strip-shaped body; a secondary bar 24 extending in parallel with the primary bar and disposed at a downstream side of the primary bar; and a between-bars liquid reservoir, the reservoir which includes the portion of reservoir or bath (313a and 313) as shown in Figure 6 which extends between the primary bar and the secondary bar for storing the coating liquid at a time of coating of the coating liquid. Mahoney shows in Figure 1 that the coating conditions at the primary bar which is supplied with the coating liquid by a coating liquid supply flow path which includes path 313b of coating between reservoir/bath 313a to reservoir/bath 313, and the secondary bar are set so that $W2 < W1$ where $W1$ is a coating amount of the coating liquid that is

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deposited on the strip-shaped body at the primary bar and W2 is a coating amount of the coating liquid that is deposited on the strip-shaped body after the strip-shaped body has passed the secondary bar since the secondary bar 351 removes excess coating from the web and applied by the primary bar therefore the total amount of coating left on the strip as the strip passes the secondary bar or W2 is less than W1 (see column 6 lines 42-45). Thus every element of the claimed apparatus is taught by Mahoney. With respect to claim 7, Mahoney is capable of coating strip-shaped body within the scope of the claim since it teaches every element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 4, Mahoney shows the coating apparatus includes an air-liquid interface forming portion for forming an air-liquid interface, which is an interface between the coating liquid and air, at the between-bars liquid reservoir at a time of coating.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2 and 4-7 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-3, 9 and 19-21 of copending Application No. 10/437,973 (Kanke et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because Kanke et al '973 claims method and apparatus for coating a coating liquid on a surface of a belt body or strip shaped body which is conveyed in a certain direction, the coating device comprising: a first side bar or primary bar which extends along a width direction which is transverse of the conveyance of the conveyance plane, wherein the conveyance plane includes the conveyance path of the strip-shaped body; a second side bar or secondary bar at a downstream side relative to the first bar, which extends in parallel with the first side bar; a coating liquid supply channel, which supplies the coating liquid at an upstream side at the first side bar; a inter-bar liquid -pooling section which reads on applicant's claimed between-bars liquid reservoir located between the first side bar and the second side bar, which accumulates the coating liquid at a time of coating of the coating liquid; and an air -liquid boundary surface formation apparatus which reads on applicant's claimed air -liquid interface forming portion which forms an air-liquid interface at the inter-bar liquid-pooling section. Kanke et al '973 claims the amount of coating supplied at the downstream side of the second bar is controlled independently from a supplied amount of the coating to the upstream side of the first bar. Therefore,

the claimed Kanke et al '973 apparatus is obviously capable of being operated such that coating amount at the primary bar is greater than the coating amount at the secondary bar such as set forth in claim 1 or the ratio of the coating amount at the primary bar relative to the secondary bar is within the scope of claim 2 as the result of the independent flow control of the coating supplied at the downstream side of the second bar relative to the flow of coating to the upstream side of the first bar. Thus claims 1-2 and 4 are obvious over Kanke et al '973. With respect to claim 5, Kanke et al '973 claims a coating liquid suction opening portion in the air-liquid interface portion and the coating liquid suction opening portion is capable of sucking the material in communication therewith, which in this case is the coating liquid stored in the between – bars liquid reservoir. With respect to claim 6, Kanke et al '973 claims a primary coating liquid flow path for supplying the coating to the upstream side of the first bar. Kanke et al '973 claims a connecting channel which includes a coating liquid suction opening connects the between – bars liquid reservoir and primary flow path. With respect to claim 7, Kanke et al '973 is capable of coating a substrate within the scope of claim since it teaches every positively claimed element of the apparatus.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 and 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 20 of copending Application No. 10/219,812 (Kanke et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because Kanke et al '812

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claims a coating device for providing a coating liquid on a surface of a belt body or strip-shaped body which is conveyed in a certain direction, the coating device comprising: primary bar or metering rod which extends along a width direction which transverse of the conveyance plane, wherein the conveyance plane includes the conveyance path of the strip-shaped body; a secondary bar or auxiliary bar at a downstream side relative to the primary bar, a between-bars liquid reservoir or auxiliary feeding device arranged between primary bar and secondary bar for feeding coating and thereby temporarily storing coating in an area between the primary bar and secondary bar. The Kanke et al '812 secondary bar or metering device removes excess coating from the web and applied by the primary bar therefore the total amount of coating left on the strip as the strip passes the secondary bar or W_2 is less than W_1 . With respect to claim 7, Kanke et al '812 is capable of coating a substrate within the scope of claim since it teaches every positively claimed element of the coating apparatus.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

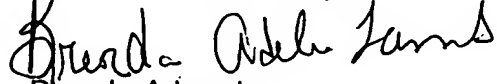
Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication should be directed to Brenda A.

Lamb at telephone number (571) 272-1231. The examiner can normally be reached on

Monday thru Tuesday and Thursday thru Friday with alternate Wednesdays off

A handwritten signature in black ink, appearing to read "Brenda A. Lamb". The signature is written in a cursive, flowing style.

Brenda A Lamb

Examiner

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